

D¹
Contd

- the weight-average molecular mass of said at least one copolyester oligomer is less than 20,000 polystyrene equivalents, as measured by gel permeation chromatography in dimethylacetamide containing 10^{-2} N of LiBr, at 100°C,

and wherein said hydrophilic gelling material comprises from 0.5 to 15% by weight of the composition relative to the total weight of the composition.

D²

24. (Twice Amended) The composition according to Claim 18, wherein up to 20% of said units of formula (I) are units of formula (I) wherein A is a 1,3-phenylene group.

D³

26. (Twice Amended) The composition according to Claim 18, wherein at least 40 mol% of said units of formula (I) are units of formula (I) wherein A is a 1,4-phenylene group and n is equal to 1.

D⁴

28. (Twice Amended) The composition according to Claim 18, wherein at least 10 mol% of said units of formula (I) are units of formula (I) wherein A is a sulfo-1,3-phenylene group.

REMARKS

I. Status of the Claims

Claims 18-21, 24-34, and 36-53 are pending and stand rejected. Applicant acknowledges and appreciates that the Examiner has withdrawn the rejections under 35 U.S.C. § 112, first and second paragraphs, and the double patenting rejection.

Without prejudice or disclaimer, claim 35 has been canceled, and claims 18, 24, 26, and 28 have been amended. Specifically, claims 18, 24, 26, and 28 have been

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amended to correct minor typographical errors, and claim 18 has also been amended to include the subject matter of canceled claim 35.

Applicant respectfully submits no new matter has been added by this proposed amendment nor does this amendment raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. All of the elements and their relationships now claimed were earlier claimed in the claims as examined. Therefore, this Amendment under 37 C.F.R. § 1.116 should allow for immediate action by the Examiner. The proposed amendments, moreover, place the claims in condition for allowance or, at least, in better form for appeal, if necessary.

As required by 37 C.F.R. § 1.121 (c)(1)(ii), Applicant has provided a marked-up version of the amended claims in the attached Appendix.

I. Rejection under 35 U.S.C. § 103(a) over O'Neill et al.

The Examiner has maintained the § 103(a) rejection of claims 18-21, 24-36, 39, and 51-53 under § 103(a) over U.S. Patent No. 4,300,580 to O'Neill et al. ("O'Neill") for the reasons set forth in the final Office Action dated February 26, 2003, at pages 2-3.

Specifically, in reply to the arguments presented in the Response filed January 16, 2003, the Examiner asserts that "since O'Neill teaches the same composition as that of the instant invention, the composition of O'Neill must have the same properties, though O'Neill does not explicitly state such properties." *Id.* The Examiner further states, citing case law, that "a compound and its properties are inseparable"; that "the viscosity of the composition comprising a compound of formula (I) is directly correlated to the structure of formula (I)"; and that "O'Neill has disclosed the general conditions of [the compound of formula (I)]." *Id.* Applicant respectfully disagrees with the Examiner's

assertions and interpretations of the case law for reasons of record, as well as those set forth below.

In particular, the Examiner still has not established that all of the elements of the instant claims are taught or suggested by O'Neill, among them the rheological and molecular weight properties, *i.e.*, the viscosity ranges and "weight-average molecular mass" recited in instant claim 18. Moreover, other than a hindsight-based analysis, which is improper, the Examiner has not explained why it would be desirable to selectively choose among the teachings of O'Neill to achieve the present invention. See M.P.E.P. 2144.08 (I) and (II)(A) (indicating that the desirability of choosing a claimed combination must be shown, even where a single reference may encompass all the elements of the claims).

Applicant respectfully points out that O'Neill generally teaches "a linear, water-dispersible polyester derived essentially from components (A) at least one dicarboxylic acid, (B) at least one diol . . . , and (C) a difunctional monomer containing a $-SO_3M$ group attached to an aromatic nucleus" Col. 1, lines 41-53. O'Neill further discloses that many different acids, diols, and monomers containing a $-SO_3M$ group attached to an aromatic nucleus may be used in formulating polyesters, but does not disclose rheological properties for these possible combinations. See col. 2, line 17- col. 3, line 63.

At best, O'Neill discloses that when a particular composition is prepared, when added to water, it "forms a dispersion which exhibits a 'dispersion viscosity' higher than that of water but lower than that which might be expected if the polymer were completely dissolved." Col. 2, lines 3-7; see *also* col. 4, lines 18-21. However, there is

no direct teaching or even a suggestion in O'Neill that indicates the viscosities, with the shear strains, recited in the claimed invention. Furthermore, O'Neill is completely silent with regard to disclosing a molecular weight for any of the possible combinations, including the examples, much less the "weight-average molecular mass" recited in the present claims, i.e., "less than 20,000 polystyrene equivalents." Instant claim 18.

In addition, the Examiner improperly relies on the case law. In particular, *In re Papesch*, cited by the Examiner for the proposition that "a compound and its properties are inseparable," actually held that a compound can be patented on the basis of its properties, i.e., "[t]here is no basis in law for ignoring any property." 315 F.2d 381, 137 U.S.P.Q. 43 (C.C.P.A. 1963) (internal citations omitted). This holding is further supported by cases that followed *Papesch*, e.g., *In re Chupp*. Specifically, the court in *Chupp* re-emphasized the viewpoint that "a compound need not excel over prior art compounds in all common properties [i.e., to be patentable]." 816 F.2d 643, 646, 2 U.S.P.Q.2d 1437, 1439 (Fed. Cir. 1987). Thus, even though O'Neill broadly discloses certain components of the copolyester oligomer of the claimed invention, the Examiner still cannot ignore the significance of the properties associated with the claimed invention and recited in the pending claims.

The Examiner also cites *In re Aller*, where the Federal Circuit held that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover optimum or workable ranges by routine experimentation." 220 F.2d 454, 456, 105 U.S.P.Q. 233, 235 (C.C.P.A. 1955). In the present case, however, O'Neill does not disclose the general conditions of the instant claims, since it does not disclose any of the claimed rheological or molecular weight properties.

Therefore, in light of these additional reasons, maintaining the rejection is improper, and thus it should be withdrawn.

II. Rejection under 35 U.S.C. § 103(a) over O'Neill in view of Lee et al.

The Examiner has also maintained the § 103(a) rejection of claims 18, 37-38, and 40-50 under § 103(a) over U.S. Patent No. 4,300,580 to O'Neill et al. ("O'Neill") in view of EP 0551748 to Lee et al. ("Lee") for the reasons set forth in the present Office Action at pages 3-4.

According to the Examiner, Applicant's previous argument was not persuasive because "it is not commensurate in scope with the instant claims, which do not recite a method of making or developing a device" and "there is a reasonable expectation of success, as both references are directed to hair care formulations comprising the same sulfopolyesters." *Id.* at 4.

Applicant respectfully disagrees with this rejection for reasons of record. Nevertheless, Applicant submits that this rejection has been rendered moot by the foregoing amendment to claim 18, which incorporated the provisions of non-rejected claim 35. Accordingly, Applicant requests that this rejection be withdrawn.

CONCLUSION

In view of the foregoing amendment and remarks, Applicant submits that the pending claims are not obvious in view of the prior art reference cited against this application. Applicant therefore requests the Office's reconsideration of the application, and the timely allowance of the pending claims.

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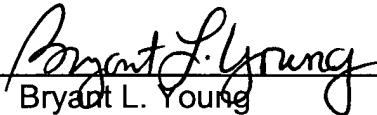
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Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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APPENDIX

**Version with markings to show changes made,
pursuant to 37 C.F.R. § 1.121 (c)(1)(ii)**

IN THE CLAIMS:

Claims 18, 24, 26, and 28 have been amended as follows:

18. (Twice Amended) A topical composition comprising an aqueous gel which comprises a hydrophilic gelling material, wherein said gel has rheological properties comprising:

- an initial viscosity V_0 ranging from 3000 to 50,000 Pa.s, wherein said initial viscosity V_0 is stable up to a shear strain C_1 ,
- a ~~[V]~~viscosity V_2 after shear at a strain C_2 , wherein a ratio of V_0/V_2 is greater than or equal to 1000, and
- a difference of C_2-C_1 is less than or equal to 100 Pa;

wherein said hydrophilic gelling material is a hydrophilic gelling polymer chosen from at least one water-soluble and water-dispersible terephthalic copolyester oligomer comprising dicarboxylate repeating units of formula [(1)] (I):



wherein

- A is chosen from 1,4-phenylene and sulfo-1,3-phenylene groups, and optionally, 1,3-phenylene groups,
- n ranges from 1 to 4,
- at least 35 mol% of said units of formula [(1)] (I) are units of formula [(1)]

(I) wherein A is a 1,4-phenylene group and n is equal to 1,

- at least 7 mol% of said units of formula [(1)] (I) are units of formula [(1)] (I) wherein A is a sulfo-1,3-phenylene group, and
 - the weight-average molecular mass of said at least one copolyester oligomer is less than 20,000 polystyrene equivalents, as measured by gel permeation chromatography in dimethylacetamide containing 10^{-2} N of LiBr, at 100°C_1
- and wherein said hydrophilic gelling material comprises from 0.5 to 15% by weight of the composition relative to the total weight of the composition.**

24. (Twice Amended) The composition according to Claim 18, wherein up to 20% of said units of formula [(1)] (I) are units of formula [(1)] (I) wherein A is a 1,3-phenylene group.

26. (Twice Amended) The composition according to Claim 18, wherein at least 40 mol% of said units of formula [(1)] (I) are units of formula [(1)] (I) wherein A is a 1,4-phenylene group and n is equal to 1.

28. (Twice Amended) The composition according to Claim 18, wherein at least 10 mol% of said units of formula [(1)] (I) are units of formula [(1)] (I) wherein A is a sulfo-1,3-phenylene group.